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In the

Supreme Court of the United States

October Term, 1984

LESLIE N. WILDER, JAMES C. WHITNEY and GARY G. MATISON,

Petitioners,

-vs-

GERALD J. MOSSINGHOFF, COMMISSIONER OF PATENTS AND TRADEMARKS and LANIER BUSINESS PRODUCTS, INC.,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTIONS PRESENTED FOR REVIEW

1. Whether it is a denial of due process for a court of appeals, without statutory authority, to use the "clearly erroneous" test in reviewing the decision of a U.S. government agency.

2. Whether the invention disclosure test adopted by the Court of Appeals for the Federal Circuit denies patentees due process in patent reissue cases by effectively denying them broadened reissue patents promised under the U.S. Patent Laws.

PARTIES BELOW

The Petitioners are Leslie N. Wilder, James C. Whitney and Gary G. Matison, who are applicants for reissue of a patent assigned by them to Dictaphone Corporation, which is a wholly-owned subsidiary of Pitney Bowes, Inc. Pursuant to Rule 28.1 of this Court, the petitioners state that only subsidiaries and affiliates of Pitney Bowes, Inc. are wholly-owned subsidiaries.

Respondent Gerald J. Mossinghoff is the Commissioner of Patents and Trademarks.

Lanier Business Products, Inc. was granted leave to intervene in the appeal to the Court of Appeals for the Federal Circuit and is a subsidiary of Harris Corporation. Harris Corporation owns a majority interest in Harris Microwave Semiconductor, Inc.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioners, Leslie N. Wilder, James C. Whitney and Gary G. Matison, pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit rendered on June 20, 1984, petition for rehearing *in banc* denied August 3, 1984.

I. OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Court is reported at ____ F.2d ____ , 222 United States Patents Quarterly 369, and is reprinted in the Appendix at page A1. [1] The opinion of the United States Patent and Trademark Office Board of Appeals is unreported and is reprinted at A10.

II. JURISDICTION

The opinion of the Court of Appeals for the Federal Circuit was rendered and its judgment entered on June 20, 1984. A timely petition *in banc* was filed by petitioner and denied in an order (A 27) issued on August 3, 1984. This petition for writ of certiorari is filed within the ninety day period provided by 28 U.S.C. §2101(c) and Rule 20.4 of this Court. The jurisdiction of this Court is invoked under the 28 U.S.C. §1254(1).

III. CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This case involves Article I, Section 8, Clause 8 of the U.S. Constitution, which states:

> "ART. 1, SEC. 8., CL. 8. The Congress shall have power. . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respecive writings and discoveries."

This case also involves Sections 141 and 144 of the Patent Act of 1952, 35 U.S.C. §§141 and 144, as amended by the Federal Courts Improvement Act of 1982.

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[1] "A" refers to pages of the Appendix bound with this Petition.

The relevant portion of §141 states:

"§141. Appeal to Court of Appeals
for the Federal Circuit

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Appeals for the Federal Circuit, . . . "

The relevant portion of §144 states:

"144. Decision on appeal

The United States Court of Appeals for the Federal Circuit, on petition, shall hear and determine such appeal on the evidence produced before the Patent and Trademark Office, and the decision shall be confined to the points set forth in the reasons of appeal. . . ."

Also involved are Sections 251 and 252 of the Patent Act of 1952, 35 U.S.C. §§251 and 252.

The relevant portion of §251 states:

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

* * *

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

The relevant portion of §252 states:

"§252. Effect of reissue

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue."

Also involved is 35 U.S.C. §112, first and last paragraphs, which are set forth below:

"§112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art

to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

* * *

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

IV. STATEMENT OF THE CASE

A. The Proceedings Below

Petitioners were granted United States Patent 4,051,540 on September 27, 1977. Later, they discovered that by error the claims of the patent had been made too narrow, and they filed an application to reissue the patent to correct the error. The application was filed within the two year period of time allowed by 35 U.S.C. §251 for the filing of such an application.

Lanier Business Products, Inc., a competitor of Dictaphone Corp., the owner of the patent, filed a protest to the reissue application.

The application was rejected by an examiner in the U.S. Patent and Trademark Office ("PTO"). Petitioners appealed to the Board of Appeals ("Board") of the PTO. The two-member majority of the Board wrote an opinion (A 10) sustaining the rejection, but the dissenting member wrote a strong dissenting opinion (A 23) in which he would have completely reversed the Examiner's decision and allowed the application. Pursuant to 35 U.S.C. §141, petitioners appealed the decision to the Court of Appeals for the Federal Circuit ("CAFC").

The majority of the Board members rejected the application on three grounds. The Court of Appeals reversed the holdings on two of those grounds (A 1, A 9), but affirmed on the third.

B. The Unprecendented "Clearly Erroneous" Ruling

The ruling which the Court sustained was that the patent did not contain an adequate description of the invention recited in the broader reissue claims and thus failed to meet the requirements of 35 U.S.C. §112 (A 9). In doing so, the Court held that the adequacy of the description was a question of fact. It then held that factual determinations of the Board of Appeals could not be overturned unless they were "clearly erroneous". Thus the Court stated (A 8):

> "We fail to see that the board's finding of inadequate description* is clearly erroneous. *In Re DeBlauwe*, Appeal No. 84-513 slip. op. at 10 (Fed. Cir., June 8, 1984), and accordingly affirm the board's rejection of claims 14-16."
> * [footnote omitted]

In this ruling, the Court made new law. Unfortunately, it did so *sua sponte*, without either argument or briefing by the parties. the only case it cited as precedent, *In Re DeBlauwe* 736 F.2d 699, was decided only twelve days prior to this one, and does not stand for the proposition for which it was cited. In that case, the Board's holding on "obviousness" was at issue; a fact finding was not at issue. On page 10 of the opinion, the Court stated:

> "A conclusion of obviousness is not reviewed under the clearly erroneous standard, which is applicable to fact findings. See *Raytheon Co.* v. *Roper Corp.*, 724 F.2d 951, 220 USPQ 592 (Fed. Cir. 1983). Rather, such a conclusion is reviewed for correctness or error as a matter of law. *In Re Carleton*, 599 F.2d 1021, 1024, n. 14, 202 USPQ 165, 169, n. 14 (CCPA, 1979)."

Thus, the holding in *De Blauwe* is that a decision on obviousness is a matter of law and is not subject to the "clearly erroneous" rule. The statement which the Court of Appeals must have relied on, that fact findings are subject to the rule, is not even dictum. Obviously, it is intended to apply only to fact decisions by federal judges because the case cited for the proposition, the *Raytheon* case, is an appeal from a decision of the United States District Court for the District of Massachusetts. This definitely is not a holding that decisions of the Board of Appeals of the Patent and Trademark Office are entitled to such deference.

The ruling in the present case is, in fact, directly contrary to prior rulings by the predecessor court, the Court of Customs and Patents Appeals ("CCPA") which the CAFC has bound itself to follow. [2] The rule in the CCPA long has been that there was no "clearly erroneous" rule or similar hurdle to be negotiated in finding error in the Board's rulings, regardless of whether the subject matter was technologically simple or complex. See *In Re Arkley*, 455 F.2d 586 (CCPA, 1972). Thus, the CCPA and, until this decision, the CAFC, both had readily substituted its judgment for that of the Patent Office without any presumptive correctness of the Patent Office decision. [3]

V. REASONS FOR GRANTING THE WRIT

A. Summary of Reasons

The single most compelling reason for granting the writ is to ensure that each party to an agency decision has the right to at least one independent review by a judge or judicial panel, unless Congress has acted to restrict that right. In so doing, this Court will correct the unprecedented use of the "clearly erroneous" rule contrary to the intent of the Congress, and will prevent the reviewing court from becoming a mere "rubber stamp" for the government agency decisions it reviews. With our ever-burgeoning bureaucracy, this is becoming ever more important to ensuring that our citizens are not denied the due process of law.

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[2] *South Corp.* v. *U.S.*, 690 F.2d 1368 (Fed. Cir., 1982).

[3] "Patent Law Perspectives", 2nd Ed., p. 9-291; Dunner, Gambrell, Adelman & Lipsey; Matthew Bender, New York, 1984.

Granting the writ also will prevent the CAFC from establishing a rule interpreting the Patent Reissue Statutes so narrowly as to deprive inventors of the due process of law. By its ruling in this case, the CAFC has made it virtually impossible to correct errors by means of a broadening reissue, thus defeating the intent of Congress in passing the Reissue Statutes.

B. The Need for Guidance From This Court

1. Existing Statutory Standards

The judicial review of some government agency decisions is enabled by specific statutes. With other agencies, there is no statute specifically enabling judicial review, and review is enabled only by the Administrative Procedure Act. [4] In many cases, the enabling legislation dictates specific standards to be used in reviewing the decision. [5] However, other such statutes, including the statute enabling judicial review of decisions of the Board of Appeals of the PTO, 35 U.S.C. §141, *supra* provide no such standards. It is in these cases that the guidance of this Court is sorely needed.

2. Adjudication By Default

In lieu of guidance from above, the CAFC apparently has adopted its own policy of applying the "clearly erroneous" rule to fact findings of all government agencies whose decisions it reviews, unless there is an explicit statutory directive to the contrary. *Heisig* v. *U.S.*, 719 F.2d 1153 (Fed. Cir., 1983). It appears that this rule may have been adopted by the CAFC not only due to lack of judicial guidance, but also due to frustration with its caseload of appeals from a large number of different tribunals. Thus, the court stated, (719 F.2d at 1158):

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[4] 5 U.S.C. §704

[5] For example, findings of facts by the Federal Trade Commission, are reviewed pursuant to the pursuant to the standards set in 15 U.S.C. §45(c). Rulemaking action by the Environmental Protection Administrator with respect to air pollution prevention may be reversed under the standards of 42 U.S.C. §1607(d)(9); but rulemaking action with respect to water pollution has no statutory standard of review, and the standards of 5 U.S.C. §706(2)(A) have been applied. *American Paper Institute* v. *Train*, 543 F.2d 328 (D.C. Cir. 1976). The standards of 5 U.S.C. §706 are statutorily mandated in reviewing decisions of the Federal Communications Commission, 47 U.S.C. §402(g).

> "The Federal Circuit is granted jurisdiction to review on appeal the judgments and decisions of over 100 lower tribunals. The standard of its review of their findings of facts is the clearly erroneous rule, unless provided otherwise by statute or by rule."

Since the CAFC has jurisdiction over the appeals from so many governmental agency decisions [6] , the above policy has an impact which reaches far beyond the area of patents and trademarks.

C. Denial of Due Process

1. Contrary to the Intent of Congress

It is a denial of due process for a court of appeals to apply the "clearly erroneous" test to findings by a government agency without specific statutory authorization.

The basic reason is that petitioners are entitled to at least one independent judicial review of an agency decision regarding their rights unless Congress has restricted that right.

As it has been shown above, Congress has acted repeatedly in recent years to establish or modify the standards of review of many different agency decisions. For example, in 1980 it acted to amend 19 U.S.C. §1337 to establish a more restrictive basis for review of U.S. International Trade Commission decisions in the area of unfair import trade practices, including patent infringement. *SSIH Equipment S.A.* v. *United States International Trade Commission*, 718 F.2d 365 (Fed. Cir., 1983).

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[6] 28 U.S.C. §1295(a) gives the CAFC jurisdiction over appeals not only from the patent and trademark decisions of the PTO, but also from decisions of the U.S. International Trade Commission; the Merit Systems Protection Board; and from any of the U.S. government boards of contract appeals.

The failure of Congress to enact a limitation on the scope of review of PTO decisions by the CAFC is particularly convincing because the CAFC came into being only two years ago. Surely, if Congress wanted the CAFC to start giving preference to PTO decisions, it had a golden opportunity to do so. The failure to do so is most meaningful.

In this case, the CAFC apparently has not taken into consideration the foregoing actions of Congress. Thus, in effect, by judicial decision it is reading into the appeal enablement statutes a limitation to the effect that an agency fact decision cannot be overturned unless it is "clearly erroneous".

It is settled that, where Congress has taken specific actions in similar legislation to provide specific limitations, but has not done so in the legislation at issue, it is not warranted to read such limitations into the legislation at issue. *Keifer & Keifer* v. *Reconstruction Finance Corp.*, 306 U.S. 381, 395, 59 S. Ct. 516, 521 (1939); *U.S.* v. *Goldenberg*, 168 U.S 95, 18 S. Ct. 8 (1897).

In the *Keifer* case, plaintiff had sued the R.F.C. for negligence in caring for its cattle. After finding congressional consent for the R.S.C. to be sued, the Court refused to limit that consent to contract actions only, holding that Congress had limited the liability of other government entities, and, having failed to do so in this case, the limitation could not be implied. [7]

The adoption of the "clearly erroneous" rule without statutory authorization is contrary to the intent of Congress and a denial of due process.

2. Denial of Independent Judicial Determination

Every litigant before a government agency ought to be entitled to at least one independent judicial review of that agency's decision, unless Congress has acted to the contrary. This is especially true where, as in this case, the rights in question are guaranteed by the Constitution.

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[7] 306 U.S. at 395, 59 S. Ct. at 521.

The granting to inventors of exclusive rights to their inventions is specifically authorized by Article I, Sec. 8, Cl. 8 of our Constitution. [8] Congress had delegated the power to grant such rights to the U.S. Patent and Trademark Office, subject to judicial review by the CAFC.

In essentially every case in which Congress has limited the scope of appellate review of agency decisions, the agency is one which provides for live testimony, and/or administrative law judges, or other safeguards to the fair administration of justice. [9]

This is not the case with appeals from the PTO Board of Appeals. There is no provision for live testimony and there are no administrative law judges. Rather, the Board consists of three senior patent examiners. [10]

Patent examiners are not judges. They do not have the lifetime tenure federal judges enjoy, and are required to act according to the current policy of the PTO. If, for example, it is the current policy of the PTO to hold the number of broadening reissue patents granted to an absolute minimum, [11] , then the Board must follow that policy. Of course, federal judges can ignore such matters.

An applicant for a constitutionally guaranteed right is entitled to at least one *independent* review of his case by a judge or panel of judges who are free from the fetters of bureaucracy. To deny that review, without authorization by Congressional action, is a denial of due process.

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[8] The full text appears in Section III above.

[9] For example, the U.S. International Trade Commission, Federal Trade Commission, Federal Communications Commission, Federal Aviation Administration and Interstate Commerce Commission provide for a full trial or hearing at which the facts can be determined.

[10] 35 U.S.C. §7

[11] This, in fact, may well be the PTO policy, in view of the relatively large number of reversals of rejections of broadening reissue applications prior to this case.

D. Limitations of the Rule

The statutory source of the "clearly erroneous" rule is Rule 52(a) of the Federal Rules of Civil Procedure, which states, in relevant part:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

The "clearly erroneous" rule is far from sacrosanct, even in appeals from the Federal District Courts . In such cases, the general rule is that the test does not apply to an appeal in a case in which there was no live testimony. In *U.S.* v. *O'Brien*, 273 F.2d 495, 497 (3rd Cir., 1959), where the case was submitted on briefs, the court held that it was in as good a position to review the evidence as the court below, and would not apply the "clearly erroneous" rule. To the same effect, see: *Moore's Federal Practice*, ¶52.04, pp. 5296 et seq. Similarly, adherence to the rule cannot be used to sanction a denial of constitutional rights such as those guaranteed by the First Amendment. *Bose Corp.*, v. *Consumer's Union of the United States, Inc.*, ____ U.S. ____ , 104 S. Ct. 1949 (1984).

The reasons for denying application of the "clearly erroneous" rule in the above cases applies doubly here where there is nothing but documentary evidence to consider, and where the panel below is not composed of judges.

Another limitation is one dictated by logic: where, as here, the decision below is determined by majority vote of a panel, and the vote is by a bare two-to-one majority, and there is a strong written dissenting opinion, application of the "clearly erroneous" rule is most illogical; if there is doubt sufficient to generate such a dissent, the "clearly erroneous" rule should not be applied.

The foregoing limitations make the "clearly erroneous" rule particularly inapplicable in this case.

E. Special Qualifications and Mandate by the CAFC

The CAFC is specially qualified to give independent review of the decisions of the PTO on patents. It is an amalgam of the former Court of Customs and Patent Appeals (CCPA) and the Court of Claims. [12] Its judges include several who specialized in patent matters in private practice.

The basic impetus for forming the CAFC was to provide a single court to decide all patent appeals, both from the District Courts and the PTO. The Court has technically trained personnel to assist it in analyzing complex technology. [13]

Thus, the CAFC has a Congressional mandate and responsibility to give every patent applicant the independent judicial review to which he or she is entitled.

F. Abrogation of the Patent Reissue Laws

In this decision, the CAFC has interpreted the patent reissue statutes so narrowly that it now is practically impossible to obtain a reissue patent broadening the claims. This is contrary to the intent of Congress and should be reversed.

The essential reason is that the Court's ruling requires, in essence, that the applicant describe the invention in his original patent application as broadly as the broadened reissue claims he later seeks. This makes it virtually impossible for the applicant to obtain a broadening reissue patent because, if he correctly understood the scope of his invention when he filed the patent application, he certainly would have claimed it broadly in the first place.

This unreasonable restraint on the reissue laws must be reversed in order to prevent virtual abrogation of the laws.

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[12] 1982 U.S. Code Cong. and Adm. News, page 12.

[13] Journal of the Patent Office Society, Vol. 66, No. 7, July 1984, Zarfas, "Treatment of Technological Issues on Appeal", page 419.

1. The Reissue Statutes - Statutes of Forgiveness

The intent of the reissue statutes is remedial - to correct errors made in claiming more or less than one had a right to claim.

The classic case of *Topliff* v. *Topliff*, 145 U.S. 156, 12 S. Ct. 825 (1891) still sets forth the basic remedies and intent of the laws: (12 S. Ct. at 831):

> "To hold that a patent can never be reissued for an enlarged claim would be not only to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee. The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention."

This intent is not served by the decision below.

2. The Dissenting Opinion Ignored

On the critical issue of adequacy of disclosure of the invention, the well-written opinion of the dissenting member of the Board stated (A 23 to A 24).

> "Claims 14, 15 and 16 have additionally been rejected under 35 U.S.C. 251 'as not being drawn to the same invention disclosed in the original patent.' These claims, however, are merely to a broader *scope* than the patented claims, principally due to the omission of a recitation requiring that the scanning of the array of

light sources be in synchronism with the scanning of the record medium. Clearly, these claims are not for a different embodiment of the invention nor to a patentably distinct invention. In addition, the feature omitted from the instant claims is not understood nor asserted to be an 'essential' element of the invention such that the omission thereof constitutes new matter or results in the lack of an enabling disclosure for the claims. *In re* Farrow, 193 USPQ 689; *In re* Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)."

"Under the applicable provision of Section 251, that the reissue be 'for the invention disclosed in the original patent,' 'intent to claim' has been held to have little to do with intent *per se*, but rather is analogous to the requirement of Section 112, first paragraph. See *In re* Mead, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). Moreover, 'intent to claim' is not an independent basis for denying a reissue application. *In re* Hounsfield, 216 USPQ 1045 (CAFC 1982). As stated in *Rasmussen*,

'As above indicated, that a claim may be broader than the specific embodiment disclosed in a specification is in itself no moment. Indeed, the statutory provision for broadened claims in reissue applications is intended to meet precisely the situation in which a patentee has claimed 'less' than he had a right to claim. 35 U.S.C. 251.'

The instant reissue application enlarging the scope of the claims of the patent was filed within the two year period in accordance with the provision of the fourth paragraph of 35 U.S.C. 251."

3. The CAFC Ruling

The CAFC totally ignored the above opinion and ruled (A 9):

"Appellants have not shown that the generic invention of claims 14-16 is supported by the original patent's

> disclosure in such a way as would indicate possession, as of the original filing date, of that generic invention."

About the only way one could meet this unprecedented requirement is to describe the invention initially as broadly as he later wishes to claim. If he understands the invention to be of that breadth, he almost certainly will claim it with that breadth from the outset, and will not make an error which needs correction.

4. Decision Contrary to Precedent

This is the only case in recent history of the CAFC and its predecessors which has refused broadened reissue claims under the circumstances of this case - that is, where the reissue claims read on the original patent disclosure and differ from the original patent claims only by omitting non-critical limitations. This ruling is directly contrary to a long line of prior decisions of the CAFC and CCPA, including: *In Re Peters*, 723 F.2d 891 (Fed. Cir., 1983); *In Re Rasmussen*, 650 F.2d 1212 (CCPA, 1981); *In Re Farrow*, 554 F.2d 468, (CCPA, 1977) and prior decisions.

The CAFC decision was reached despite the *uncontested* fact that the reissue claims read on the original disclosure of the patent application.

The decision was reached despite the further fact that the broadened claims differed from the original patent claims only in that they *omit* certain limitations which were not critical to the invention.

The invention is electrical and mechanical in nature. To the best of appellant's knowledge, this case is the *only* such case decided by either the CAFC or its predecessors in recent history in which it has been held that the disclosure of a single embodiment is not sufficient to support generic claims.

The decision in *In Re Peters*, 723 F.2d 891 (Fed. Cir., 1983) is directly applicable here. There, as here, the patent disclosed but a single embodiment of the invention. There, as here, the patentee sought to broaden the claim by eliminating limitations to non-essential features. The issue was the same, namely, whether the reissue claims were supported by the disclosure.

The CAFC ruled in *In Re Peters* as follows (723 F.2d at 893):

> "The board's rejections under §112 and §251 erroneously confined Peters to the specific embodiment disclosed in the original patent. In Re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA, 1981):
>
> '[T]hat a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment. Indeed, the statutory provision for broadened claims in reissue applications is intended to meet precisely the situation in which a patentee has claimed "less" than he had a right to claim. 35 USC §251'. 650 F.2d at 1215, 211 USPQ at 326."

The Court in *Peters* considered it important that the specification did not indicate the limitations to be critical, and that those limitations had not been made critical by arguments using the limitations to distinguish over the prior art. The same facts exist here. Here there was no prosecution of the claims beacuse they were allowed on the first Official Action, and there is no intimation in the specification that the "synchronous scanning" limitation is essential.

The CAFC attempted to distinguish the Peters case, but did not do so (A 9). The panel did *not* rule that the "synchronous scanning" limitation was necessary, and made no ruling that the reissue claims here could have properly been rejected under 35 U.S.C. §112 if they had been submitted with the original application. In fact, since they admittedly read on the specification, the claims should have been allowed if they had been presented with the original application.

The panel incorrectly relied on *In Re Kaslow*, 707 F.2d 1366, 1375, (Fed. Cir., 1983) for support of the rejection under § 112. In that case, the applicant was attempting to *add* a limitation to his claims in order to distinguish over the prior art. In fact, the same is true in *each* of the cases cited as precedent in the *Kaslow* case. Appellant is *not* attempting to *add* new limitations, but merely to eliminate unnecessary limitations.

It is very significant that the *Kaslow* case was not cited either by the Solicitor or the Intervenor in this case, probably because it is distinguishable for the above reasons. The Kaslow decision does not justify the serious departure from precedent created by the CAFC.

5. Sufficiency of a Single Embodiment

The decision also seems to rule that the disclosure of a single embodiment of the invention is not sufficient to support generic claims. The rule in this court and its predecessors long had been that, in mechanical or electrical cases, the disclosure of a single embodiment is sufficient to support a generic claim. *In Re Peters*, *supra*; *In Re Hogan*, 559 F.2d 595 (CCPA, 1977); *In Re Smythe*, 480 F.2d 1376 (CCPA, 1973).

Despite the fact that there is nothing in the specification indicating that the pertinent features of the original claims are critical or describe the only workable embodiment of the invention, the decision here rules, in effect, that a single disclosed embodiment will not support generic claims. This regression of the law should not be allowed to stand.

6. Public Policy

This decision is contrary to the basic purpose of the Reissue Statute in that it so severely limits the circumstances under which a broadening reissue patent can be obtained that inventors are and will be discouraged from seeking patents due to the subversion of substance to form which the decision creates.

The decision gives would-be infringers an unfair advantage over inventors because they can make insubstantial changes in the invention disclosed in the original patent to avoid overly-narrow original claims, knowing full well that broadening reissues have been effectively strangled by the present decision. [14]

VI. RECAPULATION

The CAFC steered its ship into uncharted waters and ran aground. It established a major change in its jurisprudence - the "clearly erroneous" rule - without briefing or argument by the parties, and without precedent. In so doing, it created a rule which denies the parties to a government agency decision an independent review by the judiciary - a rule which, without Congressional approval, denies the parties due process of the law.

In the field of patent law, the CAFC has a special expertise and a special mandate to give each inventor an independent review of an adverse decision by the Board of Appeals. Reversal of the CAFC decision is required in order to ensure this in the future.

This Court's action is needed desperately to avoid virtual extinction of broadening reissue patents. The constraints the CAFC ruling places on the well-meaning inventor totally frustrates the purpose of and policy behind the law.

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[14] The public is protected against the enlarged scope of the claims by the recognition of its "intervening rights" codified by 35 U.S.C. §252, set forth above in Section III.

The writ should be granted and the decision should be reversed.

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APPENDIX

OPINION OF THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT, DECIDED JUNE 20, 1984

United States Court of Appeals for the Federal Circuit

IN RE LESLIE N. WILDER, JAMES C. WHITNEY and GARY G. MATISON,
Appellants,

and LANIER BUSINESS PRODUCTS,
Intervenor.

Appeal No. 83-1360.

Reissue No. 079,171.

DECIDED: June 20, 1984

Before BALDWIN, *Circuit Judge*, NICHOLS, *Senior Circuit Judge*, and KASHIWA, *Circuit Judge*.

BALDWIN, *Circuit Judge*.

This appeal is from a decision of the United States Patent and Trademark Office Board of Appeals (board) rejecting claims 1-16 of appellant's Reissue Application Serial No. 079,171. Claims 1-16 were rejected for appellants' failure to sufficiently allege error required by 35 USC §251 and for failure of appellants' oath to meet the requirements of 37 CFR 1.175 (a) (5). Claims 14-16 were also rejected as being drawn to subject matter not disclosed in the original patent, U.S. Patent No. 4,051,540. We reverse the board's rejection of claims 1-16 for failure properly to allege error as required by the statute and regulation but affirm the board's rejection of claims 14-16 on the ground that the disclosure requirement has been not satisfied.

The Invention

The invention claimed in U.S. Patent No. 4,051,540 (the original patent) is a mechanism for indicating the location of information recorded on a dictation machine. A person speaking into a dictating machine indicates the location of instructions on a recording medium, such as magnetic tape, by recording control tones at the beginning or end of the instructions. A person transcribing dictated information rewinds the tape in a transcribing machine. During rewinding, the transcribing machine scans the tape and detects control tones. The locations of detected tones are stored in an electrical circuit and lights appear on a linear array that correlate with the locations of control tones on the tape. After rewinding, the transcriptionist locates specific information by advancing the tape until an indicator aligns with a light in the array.

Claim 1 of the orginal patent is reproduced below:

> 1. Apparatus for indicating the location of particular information on a previously recorded record medium, said particular information being represented by predetermined recorded signals, comprising:
>
> scanning means for scanning said record medium;
>
> an array of selectively actuable light emitting sources;
>
> *indexing means for scanning said array of light emitting sources in synchronism with the scanning of said record medium, said indexing means being in actuating relation sequentially with each of said light emitting sources;*
>
> detecting means for detecting the presence of said predetermined recorded signals during the scanning of said record medium to produce an actuating signal; and

> temporary storage means for temporarily storing said actuating signal until said indexing means is in actuating realtion with an unenergized light emitting source to energize said light emitting source. [Emphasis added.]

Claims 1-13 of the Reissue application are the same as claims 1-13 of the original patent. Unlike the original claims, reissue claims 14, 15 and 16 do not require that lights be scanned "in synchronism with scanning of said record medium." Accordingly, the original claims are directed to a species while the reissue claims are directed to the genus of indicating mechanisms that visually identify positions on a recording medium when the recording medium is scanned.

OPINION

Error Rejections

The first order of business for the board and for this court is to determine whether appellants have satisfied the requirements of 35 USC §251 and 37 CFR 1.175. *In re Clark*, 522 F.2d 623, 625, 187 USPQ 209, 211 (CCPA 1975); *In re Rowand*, 526 F.2d 558, 559, 187 USPQ 487, 488 (CCPA 1975).

The statute, 35 USC §251, provides, in pertinent part, that:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

There are two distinct statutory requirements that a reissue oath or declaration must satisfy. First, it must state that the patent is defective or partly inoperative or invalid because of defects in the specification or drawing, or because the patentee has claimed more or less than he is entitled to. Second, the applicant must allege that the defective, inoperative, or invalid patent arose through error without deceptive intent. The applicants satisfied the first requirement by alleging less was claimed in the original patent than the patentee was entitled to claim. The only issue is whether error correctable through reissue was properly alleged.

The error alleged in the first declaration filed by the inventors was that:

> [t]he true scope of the invention disclosed in the patent was not fully appreciated by us or by our attorney * * * until the commercial success of the "Thought Master" record/playback device was found to be based, at least in part, on the linear array of fixed, selectively energizable light elements, each being selectively energized to provide a visual light mark in response to a detected predetermined signal, and each being associated with a respective length of record tape, which is provided in the electronic indicator incorporated in the said "Thought Master" record/playback device * * *.

The attorney who prosecuted the original patent stated in a declaration accompanying the reissue application:

> 3. That I did not fully appreciate the true nature and scope of the invention disclosed in the original application and thus did not prepare claims of broad enough scope to provide the patent protection to which the invention properly is entitled.
>
> * * * *
>
> 6. My failure to fully appreciate the true nature and scope of the invention disclosed in the original application was without fraudulent or deceptive intention, and arose from inadvertence, accident or mistake.

In a subsequent declaration, the attorney further elaborated on the cause of his error with the following explanations:

> 7. The invention disclosed in said original application was incorporated into a dictating machine sold by the assignee of said patent under the trademark "Thought Master." When said patent issued, sales of this device had only recently begun. Subsequently, in the latter half of 1978, said assignee began marketing a modified version of a dictating machine, identified as the "Thought Master II" machine. Differences between these versions of the Thought Master dictating machines are described below.
>
> 8. In the summer of 1979, I conferred with James C. Whitney, the only one of the inventors still employed by the assignee, regarding the question of the scope of protection secured by said patent. Particularly, Mr. Whitney requested that I investigate the scope of said patent to determine if it adequately covered both versions of the Thought Master machine, and also if said patent adequately protected the broad invention disclosed therein from what Mr. Whitney believed to be possible attempts by competitors of the assignee who, in the future, might try to exploit said invention.
>
> 9. In accordance with Mr. Whitney's request, I investigated the claims of said patent in light of the prior art of which I then was aware. From my investigation, I concluded that said patent could support broader claims whose scope, broadly, is the combination of a linear array of fixed selectively energizable light elements, each being selectively energized from an inactive condition to an active condition to provide a visual light mark representing its active condition, a detector for detecting a predetermined signal as the record tape, upon which the predetermined signal is recorded, is being scanned to produce an actuating signal, a storage device for storing the actuating signal and an energizing circuit for energizing a respective

> light element, commensurate with the location of the record tape being scanned, with the stored actuating signal so as to provide, upon scanning the record tape, a display of the relative locations of the predetermined signals on the record tape. I further concluded that the limitations in the broadest claim of said patent, quoted above in paragraph 5, is [sic] not essential for practicing the broad teachings of the invention disclosed in said patent, and I advised Mr. Whitney that, because of this limitation, the scope of the patent was not adequate to protect the invention properly.
>
> 10. I recognized, when I investigated the claims of said patent, that my speculation of the prior art, as hereinabove stated, was unwarranted and erroneous.

These statements in the declarations accompanying the reissue application show that the error relied upon is the attorney's failure to appreciate the full scope of the invention. That error arose because the attorney assumed the presence of features in the prior art that were not there. The board concluded this is not error that may be corrected through reissue because the defect could have been discovered during prosecution of the original patent. The board said, "[t]here may have been a lack of prescience of the existence of a genus but such lack of prescience does not constitute an error in the sense of section 251."

The error provision of 35 USC §251 is to be liberally construed to permit correction of defects. *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294 (Fed. Cir. 1984); *In re Oda*, 443 F.2d 1200, 1203, 170 USPQ 268, 270 (CCPA 1971). An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents. The fact that the error could have been discovered at the time of prosecution with a more thorough patentability search or with improved communication between the inventors and the attorney does not, by itself, preclude a patent owner from correcting defects through reissue. In this case, the attorney's error was discovered after the commercialization of the invention and issuance of the patent.

An application for broader claims was filed within two years after the original patent issued. Under these circumstances, the attorney's explanation of his error in misunderstanding the scope of the invention is sufficient to satisfy the error requirement of 35 USC §251. We accordingly reverse the board's rejection for failure to allege error correctable through reissue.

The examiner also rejected appellants' application for failure to comply with the requirements of 37 CFR §1.175(a)(5). The board affirmed this rejection without comment. The regulation relied on by the examiner and the board requires:

> 1.175 *Reissue oath or declaration*
>
> (a) Applicants for reissue * * * must also file with their applications a statement under oath or declaration as follows:
>
> * * * *
>
> (5) Particularly specifying the errors relied upon, and how they arose or occurred.

The examiner found that applicants failed to allege facts that explain how the error arose. This finding is clearly erroneous. *In re De Blauwe*, Appeal No. 84-513, slip op. at 10 (Fed. Cir. June 8, 1984). The attorney who prosecuted the patent declared that his error, misunderstanding the scope of the invention, arose because no prior art search was done and he assumes limitations were required by the prior art without justification. This, in our view, is a sufficient explanation of how the error arose to satisfy the requirements of 37 CFR §1.175(a)(5).

Disclosure Rejection Of Claims 14-16

The board rejected claims 14-16 for inadequate description to support generic claims that do not require synchronous scanning. The description requirement is found in 35 USC §112 and is separate from the enablement requirement of that provision. *In re Bowen*, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974); *In re Smith*, 481 F.2d 910, 914-15, 178 USPQ 620, 623-25 (CCPA 1973). It is not necessary that the claimed subject matter be

described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed. *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Precisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case by case basis. *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972). We fail to see that the board's finding of inadequate description * is clearly erroneous. *In re De Blauwe*, Appeal No. 84-513, slip op. at 10 (Fed. Cir. June 8, 1984), and accordingly affirm the board's rejection of claims 14-16.

Appellants admit that the synchronous scanning equipment is only the embodiment of the invention disclosed in the original patent. To overcome the board's decision, appellants' point out that the description of one of the drawings says that dictation apparatus illustrated in the drawing is "one in which the present invention finds ready application." Appellants also note that the title of the patent "Instruction Indicating Apparatus For A Record And/Or Playback Device" is quite broad. The general description of a drawing and the broadly phrased title of the patent demonstrate, appellants contend, that other embodiments are contemplated and are sufficient to satisfy the disclosure requirement. These phrases relied upon by appellants demonstrate a desire to claim the invention as broadly as the prior art would allow. But a desire to claim as broadly as possible is the objective of most applicants for a patent. This subjective desire does not establish that the broader invention being claimed in this reissue application is adequately described in the original patent. The broadly worded title of the original patent and customarily broad description of the drawing do not satisfy the description requirement in this case.

Appellants also rely on statements in the Objects of the Invention section of the specification to satisfy the description requirement. The Objects of the Invention may, in some cases, provide support for claims sought through reissue. *In re Handel*, 312 F.2d

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* The inquiry into whether the description requirement is met is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96, (CCPA 1976); *In re Ruschig*, 379 F.2d 990, 996, 154 USPQ 118, 123 (CCPA 1967).

943, 136 USPQ 460 (CCPA 1963). They do not satisfy the disclosure requirement in this case. For instance, one of the recited objects says:

> [I]t is an object of the present invention to provide improved indicating apparatus for indicating the location of particular information on a record medium which overcomes the aforenoted problems.

The "aforenoted problems" relate to difficulties associated with paper scales graduated in minutes previously used to note the approximate place on a tape where instructions were located. In our view the board correctly read the Objects of the Invention as doing little more than outlining goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate. But the invention that achieves these general objectives must still be described. Appellants have not shown that the generic invention of claims 14-16 is supported by the original patent's disclosure in such a way as would indicate possession, as of the original filing date, of that generic invention. The present situation is to be distinguished from this court's recent decision in *In re Peters*, 723 F.2d 891 (Fed. Cir. 1983), brought to our attention by appellants. In *Peters*, the appellant successfully rebutted the PTO's rejection by proving that the broadened claims "merely omit an unnecessary limitation [the word "tapered"] that had restricted one element of the invention to the exact and non-critical shape disclosed in the original patent." *Id.* at 893. The court further commented: "Indeed, if the reissue claims had been submitted with the original application, it is difficult to perceive how they could have been properly rejected under §112." *Id.* at 894.

For the foregoing reasons, we *reverse* the board's rejection of claims 1-16 for failure to allege error correctable through reissue and the cause of the error. We *affirm* the board's rejection of claims 14-16 for claiming subject matter not adequately disclosed in the original patent.

REVERSED IN PART AND AFFIRMED IN PART

OPINION OF THE BOARD OF APPEALS
OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

Art Unit 235

Appeal No. 512-55

Heard: October 25, 1982

Ex parte Leslie N. Wilder
James C. Whitney and Gary G. Matison

Application for Patent filed September 26, 1979, Serial No. 079,171, for the Reissue of Patent No. 4,051,540, granted September 27, 1977, based on Application Serial No. 678,697, filed April 20, 1976. Instruction Indicating Apparatus for a Record and-or Playback Device.

William S. Frommer, et al. for appellants.
Eugene S. Zimmer et al. for protestor.

Primary Examiner - Robert S. Tupper.

Before Henon, Spencer, and Craig, Examiners-in-Chief.

Spencer, Examiner-in-Chief.

This appeal is from the decision of the examiner finally rejecting claims 1 through 16, all of the claims in the application.

Representative claim 14 reads as follows:

14. *In a dictation apparatus, an electronic indicator for indicating the location of particular information recorded on a record tape, which information is represented by predetermined signals, wherein the record tape is scanned and the presence of a predetermined signal is detected during said scanning, comprising a linear array of fixed, selectively energizable light elements, each being selectively energized from an inactive condition to an active condition to provide a visual light mark representing its active condition; detecting means for detecting the presence of a predetermined signal as said record tape is being scanned to produce an actuating signal; storage means for storing said actuating signal; and energizing means for energizing a respective light element, commensurate with the location of the record tape being scanned with the stored actuating signal to provide, upon scanning the record tape, a display of the relative locations of said predetermined signals on said record tape.*

Claims 1 through 16 stand rejected under 35 USC 251 as being based on an inadequate reissue declaration. Claims 14, 15 and 16 stand further rejected under 35 USC 251 as "not being drawn to the same invention as disclosed in the original patent." Claims 14, 15, 16 stand further rejected under 35 USC 112, second paragraph, as indefinite.

Reference is made to appellants' brief, reply brief and "Response to Brief and Comments of Protestor" for the position of appellants, to the brief of the protestor for the position of the protestor, Lanier Business Products, Inc. and to the answer for the position of examiner.

OPINION

The Rejection Under Section 112

We consider this rejection first since, in our opinion, the question of whether we can properly ascertain the meaning of claims 14, 15 and 16 should be resolved before we deal with the rejection of these claims under 35 USC 251 as not being drawn to "the invention disclosed in the original patent."

We have carefully reviewed the positions of the examiner and appellants on this issue. The protestor merely concurs in the rejection and sheds no light on the merits of the issue. On reading the claims in the light of the disclosure, we find no difficulty in determining what claims 14, 15 and 16 mean. In our opinion, the claims fully comply with the requirements of the second paragraph of section 112. Our review of the entire record convinces us that the examiner, in fact, had no difficulty in determining the meaning of these claims. We will not sustain the rejection.

The Rejections Under Section 251

We have carefully reviewed the positions of the examiner, appellants and the protestor on these issues. We find ourselves in agreement with the examiner and the protestor.

The original patent discloses a species of the generic invention covered by claims 14, 15 and 16. The disclosed species includes indexing means which scans an array of light elements in synchronism with the scanning of the record medium. Each of the claims of the original patent includes the limitation:

> indexing means for scanning said array of light emitting sources in synchronism with the scanning of said record medium, said indexing means being in actuating relation sequentially with each of said light emitting sources.

The generic invention is not so limited and involves a linear array of selectively energizable light elements, or visual indicators, which are selectively energized as a record medium is scanned.

Appellants contend that the description of the species is no more than a description of the best mode as required by the statute and that appellants did not regard their invention as being limited to the best mode. They assert that certain of the objects of the invention as set forth in the original patent make it clear that ap-

pellants regarded their invention as embracing the genus claimed in claims 14, 15 and 16. The objects of the invention set forth in the original patent are (bracketed numbers ours):

> [1] Therefore, it is an object of the present invention to provide improved indicating apparatus for indicating the location of particular information of a record medium which overcomes the aforenoted problems.
>
> [2] Another object of this invention is to provide an instruction indicator system for use in dictation apparatus which avoids the problem of preparing a fresh index slip for each medium to be transcribed.
>
> [3] A further object of this invention is to provide improved instruction indicator apparatus for use in dictation apparatus wherein a single index medium is used repeatedly, this same index medium being electrically marked and cleared for each record medium to be transcribed.
>
> [4] A still further object of this invention is to provide improved instruction indicator apparatus for dictation apparatus wherein the relative locations of instructions on a record medium are indicated by selectively energized sources of light.
>
> [5] An additional object of this invention is to provide an improved instruction indicator system for dictation apparatus wherein a linear array of light sources is scanned in synchronism with the scanning of a record medium to energize a corresponding light source when a recorded instruction signal is detected.
>
> [6] Another object of this invention is to provide an improved scanning mechanism for an instruction indicator system to be used in dictation apparatus.

Appellants only rely on items 1 through 4.

Object 1, considered alone, is so broad as to be meaningless insofar as shedding any light on what appellants regarded their invention to be. The "aforenoted problems" consist of (1) physical marking of the record medium was found to be unsatisfactory for an unstated reason, (2) scribe marks indicated on a slip during dictation could result in the slip being lost or otherwise separated from the record medium and (3) marking an index slip prior to transcribing in response to signals recorded on the record medium required a separate index slip thus requiring that slips be kept in ready supply. Clearly, object 1 could be achieved in many ways including trivial ones such as marking an index slip in response to recorded signals with disappearing ink. Manifestly, object 1 could support claims significantly broader than those at bar.

Object 2 is also very broad and sheds little light on what appellants regarded as their invention.

Claim 16, in not being limited to electrical actuation of the visual indicators and not being limited to selectively energized sources of light, is broader than objects 3 or 4. Technically speaking, claims 14 and 15 are also broader than object 3 since they make no reference to repeated use of the index medium or electrically marking and clearing the same index medium for each record medium to be transcribed. Each of objects 3 and 4, by itself, offers little clue as to what appellants regarded as their invention and does not support the assertion that the objects of the invention show that appellants regarded their invention as encompassing the subject matter of claims 14, 15 and 16.

In view of this analysis of the objects of the invention, we are not persuaded by appellants arguments that the objects of the invention support their contention that they considered the invention to be broader than the species claimed in the original patent and to include the subject matter of claims 14, 15 and 16. In our view, the stated objects of the invention are fully consistent with a conclusion that appellants did not consider their invention to encompass more than the species described. Further, we find it difficult to reconcile the arguments that appellants considered their invention to encompass the subject matter of claims

14, 15 and 16 with the declarations in which each of the appellants says that the subject matter of claims 14, 15 and 16 was not claimed in the original patent because he did not fully appreciate the true scope of the disclosed invention.

Nevertheless, what appellants may have considered their invention to be is not controlling. The statute provides for reissue of a patent "for the invention disclosed in the original patent."

The original patent disclosure describes a species in which indexing means scans the array of lights emitting sources in synchronism with the scanning of the record medium and in which the indexing means is in actuating relation sequentially with each of the light emitting sources. There is not the slightest hint or allusion to any other means for assuring that the appropriate lights are energized to indicate the locations of the particular information signals on the record medium. The stated objects of the invention taken in conjunction with the detailed description of the apparatus do not constitute a disclosure of a broad invention not requiring the synchronous scanning and sequential actuating relationship.

It is manifestly clear from a consideration of the total record that there is nothing in the original patent which would lead one to believe that appellants were in possession of the subject matter of claims, 14, 15 and 16, or that appellants considered the subject matter of claims, 14, 15 and 16 to be their invention. See In re Rowand, 526 F.2d 558, 187 USPQ 487 (CCPA 1975). Appellants reliance on certain of the objects set forth in the original patent along with the description of the species to constitute a disclosure of the subject matter of claims 14, 15 and 16 is not well placed. Claims 14, 15 and 16 are simply not directed to the "invention disclosed in the original patent."

The inescapable conclusion, which flows from a review of the entire record, is that appellants did not describe the broad invention defined by claims 14, 15 and 16 in the original patent because they had not conceived such a broad invention at the time of filing the application, which matured into the original patent, nor did they conceive of the broad invention during the pendency of that application.

Application S.N. 907, 035 was filed on May 17, 1978, with Matison as the inventor; the same Matison who is one of the co-inventors of the original patent and one of the applicants of this reissue application. The original patent is described in S.N. 907,035, but the description is limited to the species disclosed and claimed in the original patent. There is no hint of a broad invention, generic to that species, being disclosed in the original patent.

From the record before us, it cannot be determined whether or not attorney Frommer participated in the prosecution of S.N. 907,035. However, the firm of Curtis, Morris and Safford is common to the original patent, application of S.N. 907,035 and the instant application.

Thus, in May of 1978, two species of the generic invention were known to Matison, to the assignee of both species and to the law firm which prepared and prosecuted the applications for both. Yet, there is no evidence that any one at that time considered that the disclosure of the original patent might support claims to a genus.

With respect to the Assmann machine, a third species, and the examiner's comments on the questions raised by the protestor, appellants state in the reply brief:

> If the Examiner is implying that the the reissue application was filed only after learning of the Assmann machine, it is logical to assume that the reissue application would have been filed promptly, within weeks of the Fair, and not almost one and one-half years later.

It is also logical to assume that, had there been a concept of the genus or had appellants considered that the original patent disclosed a genus, the reissue application would have been filed within weeks of learning of the Matison species and not almost one and one-half years later after the Matison species application was filed.

In view of the position occupied by the assignee in the field of dictation machines, it is reasonable to assume that it was aware of the Assmann machine shortly after public disclosure of that machine. Thus, appellants can be reasonably charged with knowledge of three species in the spring of 1978. Yet, there was no recognition of the now alleged to be disclosure of an invention generic to the three species in the original patent, the application for which was filed some two years earlier.

Whitney, in his supplemental declaration, states that "at the time said patent [the original patent] issued, sales of the 'Thought Master' record/playback device had just begun." This can only refer to the original "Thought Master" which, from Frommer's second supplemental declaration, was on sale in 1976. Whitney goes on to say "in the summer of 1979, sales of the 'Thought Master' device had increased substantially to the point where *this device* was viewed as a commercial success" (our emphasis). This can only reasonably be interpreted to refer to the original "Thought Master." Whitney continues "I believed competitors. . . would, *in the future*, attempt to exploit *the broad invention* disclosed in said patent and I requested William S. Frommer to investigate the scope of said patent to determine if it adequately protected *this broad invention*" (our emphasis). We are left to conjecture as to just what was the broad invention which Whitney considered to be disclosed in the patent, the scope of which he requested Frommer to investigate to determine if the broad invention was adequately protected. It is clear that, at the time Whitney requested Frommer to conduct the investigation, he was not in possession of the alleged broad scope of the patent which is set forth in the first two pages of this declaration for he goes on to say "after consulting with Mr. Frommer I realized that all of the claims of said patent were too narrow to provide adequate patent protection for the broad invention because they included the aforequoted unnecessary limitation." Further, Whitney only refers to future exploitation by competitors and makes no mention of the past and then current efforts of Assmann which clearly constituted exploitation of the invention covered by claims 14, 15 and 16. It is reasonable to infer from this that Whitney's concept of the "broad invention" which prompted his request to Frommer was not a broad invention which was generic to the Assmann device.

In his second supplemental declaration, Frommer states, "[i]n the summer of 1979, I conferred with James C. Whitney. . . . Mr. Whitney requested that I investigate the scope of said patent [the original patent] to determine if it adequately covered *both versions* of the Thought Master machine, and also if such patent adequately protected the *broad invention* disclosed therein" (emphasis ours).

However, Whitney did not mention anything about two versions of the "Thought Master." As noted supra, the references by Whitney to "Thought Master" can only be reasonably interpreted to mean the original "Thought Master." There is nothing in the Whitney declaration to indicate that he felt the original patent should cover the "Thought Master II," nor is there anything in the Whitney declarations to indicate he had any reason to believe, prior to meeting with Frommer in the summer of 1979, the original patent should have covered the "Thought Master II." According to Whitney's supplemental declaration, the request to investigate was only to determine if the patent adequately protected the broad invention disclosed therein. Of course, the second supplemental declaration of Frommer casts no light on what broad invention Whitney felt was disclosed in the patent.

It is argued in the brief that Whitney requested Frommer to investigate the scope of the original patent to determine if it adequately covered the original version of "Thought Master" and an improved version which first was sold in the latter half of 1978 (manifestly "Thought Master II"). It is clear that nothing in the record including the Whitney declarations corroborates the declaration of counsel or the arguments of counsel in the brief with respect to the purpose of the investigation requested by Whitney.

In his second supplemental declaration, Frommer states that two models of the "Thought Master" were put on sale in late 1976. Model 260 was provided "with the display of light elements as disclosed in said patent" and Model 250 was provided "with an index slip and [did] not include a display of light elements." Frommer goes on to say that "a comparison of sales of these respective machines indicates that the Model 260 machine has been

commercially successful." The ratio of sales of Model 260 to Model 250 are then given for the years 1976, 1977 and 1978.

Frommer then discusses the "Thought Master II" and the two models of this dictating machine, Model 280 and Model 380 , and gives data on the ratio of the sales of Model 280/380 and Model 260 to Model 250 for the years 1978, 1979 and 1980. Frommer then adds,

> 15. The common thread of the Models 260, 280 and 380 Thought Master dictating machines is the display of light elements. Sales of these machines indicate that said machines are commercially successful, notwithstanding that the Model 260 utilizes a different type of control to energize the light elements than the Model 280/380. The machine user, in normal operation of the Thought Master dictating machine, is not concerned with the particular mechanism by which the light elements are controlled. Consequently, I believe that the commercial success of these light elements is attributed, largely, to the use of light elements to display the relative locations of predetermined signals which are played back from the record tape, which is the invention disclosed in U.S. Patent No. 4,051,540. From the sales summaries of paragraph 14, I further believe that this commercial success is not based upon particular indexing structure used in the Model 260 machine and omitted from the Model 280/380 machine. Rather, commercial success is based upon the broad invention now defined by at least Claim 14 of said reissue application.

This differs significantly from the supplemental declaration of Whitney. Whitney only mentions the "Thought Master" sales of which "had just begun" at the time the original patent issued. Whitney does not distinguish between Model 250 and Model 260 but states "in the summer of 1979, sales of the 'Thought Master' device had increased substantially to the point where this device was viewed as a commercial success; that I believed one factor which contributed to the commercial success was the use by the

'Thought Master' device of the display feature disclosed in said patent." Whitney makes no mention of the "Thought Master II" or Model 280/380, nor does he make any mention of common thread in Models 260, 280 and 380. It is not possible to determine from the record what display feature Whitney has reference to, but it is reasonable to infer that it was something common to the displays of Model 250 and Model 260. Further, since Whitney was spurred into action in the summer of 1979, it is manifest that the sales data for 1980 and all of 1979, given in the second supplemental declaration of Frommer, could not have played any part in Whitney's conclusion of commercial success or his request that Frommer investigate the scope of the original patent.

In his second supplemental declaration, Frommer states,

> 5. Although I was aware of absolutely no prior art, prior use, prior sale or prior development of dictation apparatus wherein predetermined signals on a record tape are detected and used to energize light elements so as to provide a display of the relative locations of such signals, I speculated that there might be a prior art teaching of an analogous use of light elements. This speculation was wholly without factual basis, was based on conjecture and guesswork, and is now believed to be due primarily to my inexperience, at that time, with developments in the art of dictation systems. . . . As a result, the broadest claim of said original application unnecessarily included the limitation of "indexing means for scanning said array of light emitting sources in synchronism with the scanning of said record medium, said indexing means being in actuating relation sequentially with each of said light emitting sources".
>
> . . . .
>
> 11. Due to my inexperience with developments in the art of dictation systems and my guesswork concerning such developments, I did not appreciate the true scope

> of the invention which had been disclosed to me by Messrs. Wilder, Whitney and Matison prior to the filing of said original application, and which is described in said Patent.

The clear import of this is that, as disclosed to Frommer by the inventors, the "indexing means for scanning said array of light emitting sources in synchronism with the scanning of said record medium, said indexing means being in actuating relation sequentially with each of said light emitting sources" was not necessary in order to practice the invention conceived by the inventors. However, because of speculation, conjecture and guesswork as to what the prior art might contain, Frommer included the above limitation in all of the claims. This is an improperly characterized as a failure to appreciate the "true scope of the invention which had been disclosed." If anything, there was no more than a failure to appreciate the true scope of patentability of "the invention which had been disclosed."

If this interpretation is correct, and it seems to be the only logical interpretation, we are faced with the incredulous fact that counsel not only failed to include claims without this "unnecessary" limitation but also failed to describe that the limitation was not necessary only because of speculation, conjecture and guesswork as to what might be in the prior art. This can hardly be attributed to inexperience in the art of dictation systems. In fact, inexperience in the art and lack of a prior art search would logically compel one to include the broader decription and the broader claims.

A careful analysis of the total record before us leads ineluctably to the conclusion that there was no error, in the sense of section 251, at the time of filing the application which matured into the original patent, nor was there any error, in the sense of section 251, during the prosecution of that application. There may have

been a lack of prescience of the existence of a genus but such lack of prescience does not constitute an error in the sense of section 251. At best, appellants have shown the existence of facts, not discernable until long after the granting of the original patent, which led in the summer of 1979 to the conclusion that a genus covering at least two, if not three disclosed species, existed. The discernment of the existence of a genus only occurred almost two years after the granting of the original patent and only after the disclosure of two species of genus which differed from the species disclosed in the original patent.

The late discovery of the genus and the late "finding" of a disclosure of the genus in the disclosure of the original patent does not constitute an error in the sense of section 251. Simply stated, there was no error which was correctable by way of reissue.

With respect to the examiner's findings of the deficiencies of the declarations in regard to 37 CFR 1.175(a)(5), we fully agree with the examiner's position and find it unnecessary to comment further except with respect to the additional supplemental declaration by Frommer which accompanies the reply brief.

Frommer states, in the reply brief, that the additional supplemental declaration is supplied since "the examiner has not questioned Frommer's 'experience' until now." This is patently contrary to facts evident from the complete record. Without question, the examiner had previously questioned Frommer's experience and the fact that he had questioned it was manifestly apparent to Frommer as is evident from page 33 of the principal brief. We, accordingly, treat the supplemental declaration supplied with the reply brief as merely arguments by counsel.

CONCLUSION

The rejection of claims 14, 15 and 16 under 35 USC 112, second paragraph, is reversed. The rejection of claims 1 through 16 under 35 USC 251 as being based on an inadequate reissue declaration is affirmed. The rejection of claims 14, 15 and 16 under 35 USC 251 as not being drawn to the invention disclosed in the original patent is affirmed. The decision of the examiner is, accordingly, affirmed.

AFFIRMED

Examiner-in-Chief

BOARD OF APPEALS

Craig, Examiner-in-Chief, dissenting:

I would reverse all of the rejections entered against the claims in the final Office action.

Initially, claims 14, 15 and 16, read in light of the attendant disclosure, circumscribe a particular area with a reasonable degree of precision and particularity. They therefore meet the requirements of 35 U.S.C. 112, second paragraph. See *In re* Moore, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (1971).

Claims 14, 15 and 16 have additionally been rejected under 35 U.S.C. 251 "as not being drawn to the same invention disclosed in the original patent ." These claims, however, are merely of broader *scope* than the patented claims, principally due to the omission of a recitation requiring that the scanning of the array

of light sources be in synchronism with the scanning of the record medium. Clearly, these claims are not for a different embodiment of the invention nor to a patentably distinct invention. In addition, the feature omitted from the instant claims is not understood nor asserted to be an "essential" element of the invention such that the omission thereof constitutes new matter or results in the lack of an enabling disclosure for the claims. *In re* Farrow, 193 USPQ 689; *In re* Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). Under the applicable provision of Section 251, that the reissue be "for the invention disclosed in the original patent," "intent to claim" has been held to have little to do with intent *per se*, but rather is analogous to the requirement of Section 112, first paragraph. See *In re* Mead, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). Moreover, "intent to claim" is not an independent basis for denying a reissue application. *In re* Hounsfield, 216 USPQ 1045 (CAFC 1982). As stated in *Rasmussen*,

> "As above indicated, that a claim may be broader than the specific embodiment disclosed in a specification is in itself no moment. Indeed, the statutory provision for broadened claims in reissue applications is intended to meet precisely the situation in which a patentee has claimed 'less' than he had a right to claim. 35 U.S.C. 251."

The instant reissue application enlarging the scope of the claims of the patent was filed within the two year period in accordance with the provision of the fourth paragraph of 35 U.S.C. 251.

Beginning at page 15 of the majority decision, a rationale for a rejection based upon "no error" in the original patent is advanced. This was not a basis for the examiner's rejection. Here, it appears that due to a failure to appreciate the true scope of the invention or due to speculation as to the scope and content of the prior art, particularly by appellants' attorney, claims were presented claiming less than appellants' had a right to claim. This was error and error of the type explicitly permitted to be corrected by the reissue statute. This remedial provision of the statute (35 U.S.C. 251) should be *liberally* construed. *In re* Oda, 58 CCPA

1353, 443 F.2d 1200, 170 USPQ 268 (1971). I therefore find no basis for entering a rejection upon the rationale of "no error" in the original patent.

All of the claims at bar stand rejected under 35 U.S.C. 251 as being based upon an inadequate reissue declaration(s), in particular, one that fails to comply with 37 CFR 1.175(a)(5). The examiner in his answer, asserts that the declarations are not adequate because they do not present a factual basis for

> "(1) the 'assumption' that the prior art would require the limitation of indexing means;
>
> (2) the viewing of the 'Thought Master' as a commercial success;
>
> (3) the conclusion that such success was attributed to the use of the invention disclosed; and
>
> (4) the basis for the failure to appreciate the true scope of the invention."

Rule 175, subsection (a)(5) requires a statement,

> "Particularly specifying the error or what might be deemed errors relied upon, and how they arose or occurred."

Here, the error is specified in the supplemental declarations of the appellants, i.e., the patented claims contain a nonessential limitation to indexing means for scanning the record medium and light sources in synchronism. It is averred that the error arose because the true scope of the invention was not appreciated and the limitation was included in the patent claims based upon an assumption that the prior art would require same. Usually such

general statements suffice. See M.P.E.P. 1400 and *In re* Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). An inquisition delving into the factual basis for the erroneous assumption and failure to appreciate the true scope of the invention is not directed by section (a)(5) of the rule. Appellants have also stated how and when they became aware of the error. Whether the invention was or was not a commercial success or considered to be a commercial success has no bearing on satisfying the requirement of the rule. I hold that on the facts of this case the declarations fairly meet the requirements of 37 CFR 1.175 (a)(5).

BOARD
Examiner-in-Chief OF
APPEALS

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United States Court of Appeals for the Federal Circuit

IN THE MATTER OF APPLICATION OF
LESLIE N. WILDER,
JAMES C. WHITNEY and
GARY G. MATISON,
Appellants,
and LANIER BUSINESS PRODUCTS,
Intervenor.

Appeal No. 83-1360.

Reissue No. 079,171

ORDER

A petition for rehearing and a suggestion for rehearing in banc having been filed in this case,

UPON CONSIDERATION THEREOF, it is Ordered by the court that the petition for rehearing be, and the same is hereby Denied.

The suggestion for rehearing in banc is declined.

For the Court

George E. Hutchison, Clerk

August 3, 1984
Date

cc: Gregor N. Neff
Thomas E. Lynch
Eugene S. Zimmer

IN THE SUPREME COURT OF THE UNITED STATES

October Term, 1984

LESLIE N. WILDER, JAMES C. WHITNEY
and GARY G. MATISON
Petitioners,

- v.-

GERALD J. MOSSINGHOFF,
Commissioner of Patents and Trademarks,
and LANIER BUSINESS PRODUCTS,
Respondents.

STATE OF NEW YORK, COUNTY OF NEW YORK ss.:

The undersigned, being duly sworn, deposes and says that deponent is over 18 years of age, resides in New York, New York and is not a party to the above-captioned action. Deponent further states that on October 24, 1984 she mailed 3 copies of the Petition for Writ of Certiorari to: THOMAS LYNCH, Office of the Solicitor, U.S. Patent and Trademark Office, P.O. Box 15667, Arlington, VA 22215, Attorney for Respondent Gerald Mossinghoff; EUGENE ZIMMER, of Counsel to Jones, Thomas & Askew, P.O. Box 56326, Atlanta, GA 30343, Attorneys for Respondent Lanier Business Products; SOLICITOR GENERAL OF THE UNITED STATES, Department of Justice, Washington, D.C. 20530.

Sworn to before me this twenty-fourth day of October 1984

Maya Kennedy

Notary Public

MYRON S. SCHONFELD
NOTARY PUBLIC, State of New York
No. 24-4759300
Qualified in Kings County
Commission Expires March 30, 19[illegible]